

Notice of Allowability

Application No.

10/506,657

Examiner

Marc S. Zimmer

Applicant(s)

LAUTENSCHLAGER ET AL.

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 09/03/04 and the interview conducted 07/18/06.
2. ☒ The allowed claim(s) is/are 15-30.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date ~~10-3-04~~ 11-3-04
- ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
- ☐ Notice of Informal Patent Application (PTO-152)
- ☒ Interview Summary (PTO-413),
Paper No./Mail Date _____
- ☒ Examiner's Amendment/Comment
- ☒ Examiner's Statement of Reasons for Allowance
- ☐ Other _____

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with William Conger on July 18, 2006.

The application has been amended as follows:

Please replace the first four lines of claim 15 with,

-- 15. In a process for the coating of substrates with crosslinkable silicone(s) wherein an antimisting additive is employed for reducing the formation of aerosol, the improvement comprising adding to said crosslinkable silicone(s) at least one antimisting additive which is an alkenyl-functional siloxane copolymer comprising --.

Likewise, in claim 18, please replace the first four lines with,

-- 18. In a process for the coating of substrates with crosslinkable silicone(s) wherein an antimisting additive is employed for reducing the formation of aerosol, the improvement comprising adding to said crosslinkable silicone(s) at least one antimisting additive which is an alkenyl-functional siloxane copolymer prepared by --.

The Examiner had advised Applicant that the original language of these claims was considered problematic because it wasn't clear what steps precisely Applicant had regarded as

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essential to the claimed method. Specifically, it had been only implied that the alkenyl-functional organopolysiloxane set forth therein was to be added to a crosslinkable silicone composition and the only step affirmatively stated was that of “selecting” said organopolysiloxane. The amendments supra serve to rectify the inadequacies of the claims as they had been originally presented.

Allowable Subject Matter

Applicant is advised that, for the purpose of evaluating the claimed invention against the prior art, the phrase “crosslinkable silicone(s)” was taken as referring to a polysiloxane compound, or compounds, that is/are crosslinkable without any other materials being present. In the Examiner’s estimation, this is an important distinction because organohydrogensiloxanes, for instance, are crosslinkable but not in the absence of a compound bearing at least two alkenyl groups. (Technically, this is not entirely true as organohydrogensiloxanes may react with themselves via dehydrogenation, but only in the presence of specific catalysts.)

In any case, the Examiner felt that it was necessary to make this distinction because a couple of references were found that disclose mixing a polymer equivalent to that outlined in claims 15 and 18 with an organohydrogensiloxane and a platinum hydrosilylation catalyst. Were the claims to be satisfied, the organohydrogensiloxane and platinum catalyst, by themselves, would have to represent a crosslinkable silicone composition as the claims require that the alkenyl-functional organopolysiloxane is added to a crosslinkable silicone(s). In both U.S. Patent no. 5,386,007 and no. 5,241,034, an equivalent alkenyl-functional organopolysiloxane is combined with an organohydrogenpolysiloxane and catalyst wherein the three materials together comprise a crosslinkable silicone. Herzig et al., U.S. Patent no.

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6,451,909 also teaches an equivalent polymer but not its addition to a crosslinkable silicone composition. Herzig et al., U.S. Patent no. 6,759,094 is the US equivalent of the EP document that had been cited as being especially germane to the presently claimed invention. The Examiner has reviewed the teachings of that reference and concluded that it fails to anticipate the claims for at least the reason that the organohydrogensiloxane and polyene are furnished in stoichiometries that provide more hydrosilyl groups than alkene groups. As a result, there would be no groups of the type $AR_cSiO_{4-(c+1)/2}$ because it would be expected that all of the alkenyl groups are consumed in their reaction. Certainly, the reference does not expressly disclose the presence of these units in the final product.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 18, 2006

A handwritten signature in black ink, appearing to read "Marc S. Zimmer".

MARC S. ZIMMER
PRIMARY EXAMINER